



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,756	10/16/2000	Fatih M. Uckun	12152.76USD1	1604
23552	7590	08/27/2002	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			LIU, HONG	
		ART UNIT	PAPER NUMBER	
		1624	DATE MAILED: 08/27/2002 9	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/688,756

Applicant(s)

Uckun et al.

Examiner

Hong Liu

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jul 8, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1835 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 30-35 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 30-35 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

Art Unit: 1624

## **DETAILED ACTION**

Claims 30-35 are pending in this application.

This action is in response to the applicants' amendment and reply filed on July 8, 2002.

### ***Response to Arguments***

Applicants' arguments filed on July 8, 2002 have been fully considered but they are not persuasive. Rejections to Claims under 35 U.S.C. 102(b) and 103(a) are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

Claims 30, 32, 33, and 35 remain rejected under 35 U.S.C. 102(b) as being anticipated by Myers et al. (WO 95/15758). Applicants' arguments have been fully considered but they are not found persuasive. Applicants argue that the reference fails to disclose UVB-radiation-induced inflammatory response even though the reference does teach anti-inflammatory response in general and thus, the claims are not anticipated by the teaching of the reference. While a sound 102 rejection requires that the reference teach every element of the invention, "an anticipatory reference....need not duplicate word for word what is in the claims. Anticipation can occur when the claimed limitation is 'inherent' or otherwise implicit in the relevant reference." *Standard Havens Products, Inc. V. Gencor Indust.*, 953 F.2d 1360 (Fed. Cir. 1991). The 758' reference

clearly shows that the 6,7-dimethoxy quinazoline compounds possess inherently anti-inflammatory activities. Hence, whether the inflammation is induced by UVB radiation or other causes is not particularly relevant. It is equally irrelevant whether the compounds' modes of action are inhibition of JAK3 or CSF-1R. The phrase "UVB-radiation-induced" could be viewed as a preamble. However, the preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. In *Integra LifeSciences*, the court disregarded the arguments that the preamble "a method of inhibiting animal cell proliferation..." specifically limited the scope of the claim whereas the reference discussed no such limitation. The court's reasoning was that "methods underlying plaintiff's claims invention will remain the same" whether the reference taught such a limitation or not.

In *Ex parte Novitski*, the Board held that a 102 rejection should be applied to a claim which states "a method for protecting a plant from pathogenic nematodes which comprises the step of inoculating said plant with a nematode-inhibiting strain of *P. cepacia*..." with a reference which discloses inoculation a plant with *Pseudomonas cepacia* type Wisconsin 526 even though the reference does not expressly disclose that *Pseudomonas cepacia* type Wisconsin 526 possesses nematode-inhibiting activity. Such an express disclosure is unnecessary because *Pseudomonas cepacia* type Wisconsin 526 inherently possess nematode-inhibiting activity. The same reasoning could be applied to the instant case. Even though the reference does not expressly disclose that the compounds can be used for UVB-induced inflammatory response, the 6,7-dimethoxy quinazoline compounds inherently possess anti-inflammatory activities including the inflammatory response caused by UVB radiation. The compounds also inherently possess the

property of inhibiting the release of prostaglandin E2 as it is well known that PGE2 is an inflammatory mediator.

***Claim Rejections - 35 USC § 103***

Claims 30-35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (WO 95/15758) for the same reasons given above.

***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are

unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl

August 20, 2002



**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**